



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No.: PTO-P-2023-0041]

Semiconductor Technology Pilot Program

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is implementing the Semiconductor Technology Pilot Program, which is designed to accelerate improvements in the semiconductor industry by expediting examination of patent applications for certain semiconductor manufacturing innovations. The pilot program is intended to encourage research, development, and innovation in the semiconductor manufacturing space and provide equitable intellectual property protection to incentivize investments in the semiconductor manufacturing area. Expediting examination of patent applications directed to semiconductor manufacturing under this pilot program encourages innovations that increase semiconductor device production, reduce semiconductor manufacturing costs, and strengthen the semiconductor supply chain. Applications accepted into the pilot program will be advanced out of turn (accorded special status) for examination until a first Office action is issued. This notice outlines the conditions, requirements, and guidelines of the pilot program.

DATES: *Pilot Duration:* The Semiconductor Technology Pilot Program will accept petitions to make special beginning [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER] until either **December 2, 2024** or the date the USPTO accepts a total of 1,000 grantable petitions, whichever occurs first. The USPTO may, at its sole discretion, terminate the pilot program depending on factors such as workload and resources needed to administer the program, feedback from the public, and the

effectiveness of the program. If the pilot program is terminated, the USPTO will notify the public. The USPTO will indicate on its website at www.uspto.gov/SemiconductorTechnology the total number of petitions filed and the number of applications accepted into the pilot program.

FOR FURTHER INFORMATION CONTACT: For general questions regarding this pilot program, please contact Steven J. Fulk, Legal Advisor, at 571-270-0072 or Steven.Fulk@uspto.gov; Nalini Mummаланeni, Senior Legal Advisor, at 571-270-1647 or Nalini.Mummаланeni@uspto.gov; or Susy Tsang-Foster, Senior Legal Advisor, at 571-272-7711 or Susy.Tsang-Foster@uspto.gov, all from the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. For questions relating to a particular petition, please contact Bumsuk Won, Management Quality Assurance Specialist, at 571-272-2713 or Bumsuk.Won@uspto.gov; or William Kraig, Supervisory Patent Examiner, at 571-272-8660 or William.Kraig@uspto.gov, both of Technology Center 2800. For questions on electronic filing, please contact the Patent Electronic Business Center (EBC) at 866-217-9197 (during its operating hours of 6 a.m. to midnight ET, Monday–Friday) or ebc@uspto.gov.

SUPPLEMENTARY INFORMATION: New patent applications are normally taken up for examination in the order of their U.S. filing date or national stage entry date. See sections 708 and 1893.03(b) of the Manual of Patent Examining Procedure (9th ed., Rev. 07.2022, February 2023) (MPEP). The USPTO has procedures under which an application will be advanced out of turn (accorded special status) for examination if the applicant files (1) a petition to make special under 37 CFR 1.102(c) or (d) with the appropriate showing, or (2) a request for prioritized examination under 37 CFR 1.102(e). See 37 CFR 1.102(c)-(e) and MPEP 708.02, 708.02(a), and 708.02(b). The USPTO revised its accelerated examination procedures effective August 25, 2006, requiring that all petitions to make special comply with the requirements of the revised accelerated

examination (AE) program set forth in MPEP 708.02(a), except those based on an inventor's health or age or the Patent Prosecution Highway (PPH) Pilot Program. See *Changes to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination*, 71 FR 36323 (June 26, 2006).

The USPTO is implementing the Semiconductor Technology Pilot Program to support the Creating Helpful Incentives to Produce Semiconductors (CHIPS) Act of 2022 (see Pub. L. No. 117-167, 136 Stat. 1366 (2022)), which provides appropriations to implement the semiconductor provisions included in the William M. (Mac) Thornberry National Defense Authorization Act for Fiscal Year 2021 (see Pub. L. No. 116-283, 134 Stat 3388 (2021)). The pilot program also supports Executive Order 14080, dated August 25, 2022, which implements the incentives for semiconductor manufacturing provided by the CHIPS Act. See Executive Order 14080 of August 25, 2022, Implementation of the CHIPS Act of 2022, 87 FR 52847 (August 30, 2022). The CHIPS Act allocates transformative investments that are designed to increase semiconductor manufacturing capacity and improve the resilience of the semiconductor supply chain. The Semiconductor Technology Pilot Program supports the CHIPS Act by encouraging research, development, and innovation in the semiconductor manufacturing space and providing equitable intellectual property protection to incentivize investments in the semiconductor manufacturing area. Expediting examination of patent applications directed to certain processes and apparatuses for manufacturing semiconductor devices under this pilot program can help achieve the goals of the CHIPS Act by encouraging innovations that increase semiconductor device production, reduce semiconductor manufacturing costs, and strengthen the semiconductor supply chain.

The pilot program permits an application that claims certain processes or apparatuses for manufacturing semiconductor devices to be advanced out of turn (accorded special status) until a first Office action is issued without meeting all of the requirements of the

accelerated examination program set forth in MPEP 708.02(a) (for example, examination support document) if the applicant files a petition to make special under 37 CFR 1.102(d) meeting all of the requirements set forth in this notice.

To qualify for the pilot program, the applicant must file a petition to make special under the pilot program, and the application must claim an invention directed to certain processes or apparatuses for manufacturing semiconductor devices. The applicant must certify in the petition to make special that: (1) the applicant has a good faith belief that the claimed invention(s) meeting the technology requirement of the pilot program improves the manufacturing of semiconductor devices; (2) the process or apparatus covered by the claimed invention(s) meeting the technology requirement of the pilot program is disclosed in the specification as being primarily focused on the manufacturing of semiconductor devices; (3) the applicant has a good faith belief that expediting examination of the application will have a positive impact on the semiconductor manufacturing industry, such as increasing semiconductor device production, lowering semiconductor manufacturing costs, or increasing the resilience of the semiconductor supply chain; and (4) the inventor or any joint inventor has not been named as the inventor or a joint inventor on more than four other nonprovisional applications in which a petition to make special under this pilot program has been filed. Applications accepted into the pilot program will be advanced out of turn (accorded special status) until a first Office action is issued without meeting all of the current requirements, including any extra fee payments, of the accelerated examination program (for example, the requirement for an examination support document) or the prioritized examination program (for example, the prioritized examination fee or processing fee).

All other requirements of the accelerated examination program that are not required by this notice, including the 37 CFR 1.17(h) fee for a petition to make special under 37 CFR 1.102(d), are hereby waived based upon the special procedure specified in this notice. No

fees or requirements other than those discussed above are waived by this pilot program. The USPTO will periodically evaluate the pilot program to determine whether and to what extent its coverage should be expanded or limited.

Part I. Requirements to Participate

A petition to make special under the pilot program may be granted in an application provided that the following conditions are satisfied:

(1) Types of Applications and Time for Filing Petition

The petition to make special under the pilot program must be filed:

- a) with the filing of a noncontinuing original utility nonprovisional application or entry into the national stage under 35 U.S.C. 371, or within 30 days of the filing date or entry date of the application; or
- b) with the filing of an original utility nonprovisional application claiming the benefit of an earlier filing date under 35 U.S.C. 120, 121, 365(c), or 386(c) of only one prior nonprovisional application or only one prior international application designating the United States or within 30 days of the filing date of such application.

Definition

Noncontinuing application: A noncontinuing application is an application that is not a continuation, divisional, or continuation-in-part application filed under the conditions specified in 35 U.S.C. 120, 121, 365(c), or 386(c) and 37 CFR 1.78. See MPEP 201.02.

The pilot program is reserved for the nonprovisional applications described above that have not received a first Office action (including a written restriction requirement). Any application that claims the benefit of the filing date of two or more prior filed applications that are nonprovisional U.S. applications and/or international applications designating the United States is not eligible for participation in the pilot program. Claiming the benefit under 35 U.S.C. 119(e) of one or more prior provisional applications

or claiming a right of priority under 35 U.S.C. 119(a)-(d) or (f) to one or more foreign applications will not affect eligibility for the pilot program.

(2) Office Form Required for Filing Petition

To participate in this pilot program, an applicant must file a petition to make special using form PTO/SB/467, titled “CERTIFICATION AND PETITION TO MAKE SPECIAL UNDER THE SEMICONDUCTOR TECHNOLOGY PILOT PROGRAM” (available at www.uspto.gov/PatentForms). Form PTO/SB/467 contains the necessary certifications for qualification to participate in the pilot program. Use of the form will enable the USPTO to quickly identify and timely process the petition. In addition, use of the form will help applicants understand and comply with the petition requirements of the pilot program. Under 5 CFR 1320.3(h), form PTO/SB/467 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995.

(3) The Application Must Include at Least One Claim That Meets the Technology Requirement

The application must contain at least one claim that covers a process or an apparatus for manufacturing a semiconductor device and corresponds to one or more of the technical concepts within H10 (Semiconductor Devices; Electric Solid-State Devices Not Otherwise Provided For) or H01L (Semiconductor Devices Not Covered by Class H10) in the Cooperative Patent Classification (CPC) system.

The full schemes of the H10 class and the H01L subclass are available at www.uspto.gov/web/patents/classification/.

(4) Required Certifications

The petition to make special must certify that: (a) the applicant has a good faith belief that the claimed invention(s) meeting the technology requirement of the pilot program improves the manufacturing of semiconductor devices; (b) the process or apparatus covered by the claimed invention(s) meeting the technology requirement of the pilot

program is disclosed in the specification as being primarily focused on the manufacturing of semiconductor devices; (c) the applicant has a good faith belief that expediting examination of the application will have a positive impact on the semiconductor manufacturing industry, such as increasing semiconductor device production, lowering semiconductor manufacturing costs, or increasing the resilience of the semiconductor supply chain; and (d) the inventor or any joint inventor has not been named as the inventor or a joint inventor on more than four other nonprovisional applications in which a petition to make special under this pilot program has been filed. Form PTO/SB/467 contains these certifications.

(5) Publication Requirement for Applications

If the applicant files the petition to make special on the date of filing of an application, the application may not be filed with a nonpublication request. If the applicant previously filed a nonpublication request in the application, the applicant should file a rescission of the nonpublication request no later than the time the petition to make special is filed. The applicant may use form PTO/SB/36 to rescind the nonpublication request.

(6) Claim Limits and No Multiple Dependent Claims

The application must contain no more than three independent claims and no more than 20 total claims (“program claim limits”) and must not contain any multiple dependent claims. If an application exceeds three independent claims or 20 total claims, or if it contains any multiple dependent claims, the applicant should file a preliminary amendment in compliance with 37 CFR 1.121 to cancel any excess claims or multiple dependent claims no later than the date the petition to make special under the pilot program is filed. After an application has been granted special status under the pilot program, any amendment that does not comply with the program claim limits or adds a multiple dependent claim is not permitted. The petition must include a statement that the applicant agrees not to exceed the program claim limits or add any multiple dependent

claims during the remainder of prosecution of the application if the application has been granted special status under the pilot program. The examiner may refuse entry of any amendment filed in reply to an Office action that, if entered, would result in a set of pending claims that exceeds the program claim limits or adds a multiple dependent claim. See Part V of this notice.

(7) Statement Regarding Restriction Requirement, Elected Invention and Claim Requirements

The petition must include a statement that the applicant agrees to the following if the application is granted special status under the pilot program:

(a) If a requirement for restriction or unity of invention is made, the applicant will make an election to an invention that meets the technology requirement of this pilot program, and

(b) During the remainder of prosecution of the application: (i) the applicant will not exceed the program claim limits or add any multiple dependent claims; and (ii) the applicant will not cancel all claims to the elected invention or all claims that meet the technology requirement of this pilot program.

(8) Electronic Filing of Application and Petition Required

The petition to make special may only be made by filing form PTO/SB/467, which must be filed electronically using the USPTO's Patent Center (at <https://patentcenter.uspto.gov>). Applicants must file the petition using the document description ("Petition for Semiconductor Pilot") indicated on form PTO/SB/467. In addition, the application or national stage entry must be filed using Patent Center.

(9) Required Use of DOCX Format for Specification, Claim(s), and Abstract on Filing or on National Stage Entry

The specification, claim(s), and abstract of the application must be submitted in DOCX format at the time the application is filed or enters the national stage. Prior to

submitting the application for filing in DOCX format, applicants will receive a feedback document. Applicants may find it beneficial to review the feedback document and make corrections to the application before filing the application. By making the necessary corrections before filing, applicants may avoid delays that can occur in the pre-examination process. For more information on DOCX filing in Patent Center, please see www.uspto.gov/patents/docx. Applicants can direct any inquiries concerning electronic filing of the petition and application to the EBC at 866-217-9197 or ebc@uspto.gov.

(10) Filing Limitations

An applicant may file a petition to participate in the pilot program if the inventor or any joint inventor has not been named as the inventor or a joint inventor on more than four other nonprovisional patent applications in which a petition to make special under this pilot program has been filed. In other words, the inventor or any joint inventor named on the application can only be named as the inventor or a joint inventor on a maximum of five nonprovisional applications in which a petition under the pilot program has been filed. Therefore, if the inventor or any one of the joint inventors of the instant application has been named as the inventor or a joint inventor on more than four other nonprovisional applications in which petitions under this pilot program have been filed, then the petition for the instant application may not be appropriately filed.

Part II. Internal Processing of the Petition Under the Pilot Program

If the applicant files a petition to make special under the pilot program, the USPTO will not render a decision on the petition until the application has completed pre-examination processing. Any inquiries concerning a particular petition to make special should be directed to the appropriate Technology Center handling the petition. If the petition is granted, the application will be accorded special status under the pilot program. The application will be placed on an examiner's special docket until a first Office action is issued. After the first Office action, the application will no longer be

treated as special during examination. For example, if an amendment is filed in response to a first Office action, it will be placed on the examiner's regular amended docket.

If the petition to make special under the pilot program does not comply with the requirements set forth in this notice, the USPTO may notify the applicant of the deficiency by issuing a notice. The notice will give the applicant only *one opportunity* to correct the deficiency. If the applicant still wishes to participate in the pilot program, the applicant must file a reply via Patent Center that includes appropriate corrections and a properly signed petition form PTO/SB/467 within one month or 30 days, whichever is longer, from the mail/notification date of the notice informing the applicant of the deficiency. The time period for reply is *not* extendable under 37 CFR 1.136(a). If the applicant fails to correct the deficiency indicated in the notice within the time period set , the application will not be accepted into the pilot program and will be taken up for examination in accordance with standard examination procedures.

In addition, the petition will be dismissed without an opportunity for correction if any of the following deficiencies exists: (1) the application does not contain a claim that meets the technology requirement of the pilot program; (2) the process or apparatus for the manufacturing of semiconductor devices covered by the claim meeting the technology requirement is not disclosed in the specification as being primarily focused on the manufacturing of semiconductor devices; (3) the application or national stage entry was not filed electronically in Patent Center; (4) the specification, claim(s), and abstract of the application were not submitted in DOCX format at the time of filing or national stage entry; (5) the application is not an original (non-reissue), nonprovisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage under 35 U.S.C. 371; (6) the application claims the benefit of the filing date of two or more prior filed applications that are nonprovisional U.S. applications and/or international applications designating the United States; and (7) the petition was

not filed with the application or national stage entry or within 30 days of the application's filing date or national stage entry date.

Part III. Requirement for Restriction or Unity of Invention

If the claims in the application are directed to multiple inventions, the examiner may make a requirement for restriction or unity of invention in accordance with current restriction practice. If such a requirement is made, the applicant must make an election to an invention that meets the technology requirement of this pilot program.

Part IV. Period for Reply by the Applicant

The time periods set for reply in Office actions for an application granted special status under the pilot program will be the same as those set forth in MPEP 710.02(b).

Part V. Replies by the Applicant Under the Pilot Program

During the remainder of prosecution of an application granted special status under the pilot program, the applicant's replies to Office actions must be fully responsive to the rejections, objections, and requirements made by the examiner. Any amendment or election filed in reply to an Office action may be treated as not fully responsive if it attempts to: (1) add claims that would result in more than three independent claims or more than 20 total claims pending in the application; (2) add any multiple dependent claim(s); (3) cancel all claims that meet the technology requirement of the pilot program; (4) elect an invention that does not meet the technology requirement of the pilot program, or (5) cancel all claims to the elected invention.

If a reply to a nonfinal Office action is not fully responsive for any of the reasons set forth above but is a genuine attempt to advance the application to final action, the examiner may, at their discretion, issue a notice of nonresponsive amendment and provide a shortened statutory period of two months for the applicant to supply a fully responsive reply. Extensions of this time period under 37 CFR 1.136(a) to the notice of nonresponsive amendment will be permitted, but in no case can any extension carry the

date for reply to this notice beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133). However, any further nonresponsive amendment typically will not be treated as genuine, and therefore, the time period set in the prior notice will continue to run.

Part VI. After-Final and Appeal Procedures

Any amendment, affidavit, or other evidence after a final Office action and prior to appeal must comply with 37 CFR 1.116. During the appeal process, the application will be treated in accordance with the normal appeal procedure (see MPEP Chapter 1200).

Part VII. Withdrawal from the Pilot Program

There is no provision for withdrawal from the pilot program. An applicant may abandon an application that has been granted special status under the pilot program in favor of a continuing application. However, a continuing application will not automatically be granted special status based on the petition filed in the parent application. Each application (including each continuing application) must, on its own merit, meet all requirements for special status under the pilot program, and be accompanied by its own petition as detailed in Part I above.

Katherine Kelly Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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